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10/537,277	05/27/2005	Yoshio Onoda	09610/0202789-US0	2231

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EXAMINER

WALKER, NED ANDREW

ART UNIT	PAPER NUMBER
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3781

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11/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,277	Applicant(s) ONODA, YOSHIO	
	Examiner NED A. WALKER	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 3-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/04/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's argument, see amendment filed August 5th, 2008, with respect to Claim 1 being generic to all claims that depend therefore has been fully considered and is persuasive. Examiner therefore acknowledges Claim 1 is generic and that if found allowable as a generic claim will provide the Applicant to rejoin any dependent claims that have been withdrawn as corresponding to other species.
2. Currently Claims 1-18 are pending and Claims 3-18 are withdrawn.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on August 5th, 2008 was filed after the mailing date of the non-final rejection on June 5th, 2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Furthermore, the IDS is afforded the original filing date of September 1, 2005 since the Applicant has provided evidence that the SB/08 document was received by the Office along with the additional documentation, but was not properly added to the official file. The document has now been properly added to the record.

Drawings

4. The replacement drawing sheets were received on August 5th, 2008. These drawings are accepted.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title should include at least one technical or inventive feature set forth in the application.

Claim Objections

6. Claim 2 is objected to because of the following informalities: please delete the extraneous parenthesis “)” in line 2 of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 14-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Diaz (US Pat. No. 5,139,163).

Regarding claim 1, Diaz teaches a cap (20) disposed around a lid of a container for canned drinks comprising: a seal face part (22) made as a film to expand and contract (column 3 lines 47-56) and covers a top face of said container for canned drinks; an outer-perimeter part (28) being an elastic material to expand and contract (column 3 lines 47-56 and col. 4, lines 37-44) and is disposed on an outer perimeter of said seal face part (figures 1-2); wherein an entire top face of said container for canned

Art Unit: 3781

drinks is covered in a water-tight manner by said seal face by attaching said outer-perimeter part below a seam part of said container for canned drinks (figures 1-2, 6).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being obvious over Diaz (US Pat. No. 5,139,163) as applied to claim 1 above, in view of Deline (US Pat. No. 4,708,257).

Regarding claim 2, Diaz, as applied to claim 1 above, teaches wherein: said seal face part and outer-perimeter part are made of at least one of polystyrene and polypropylene by injection molding as one unit; a thickness of said outer-perimeter part is equal to 0.5 mm or greater (column 3 lines 47-56).

Diaz does not disclose a thickness of said seal face part is equal to 0.4 mm or less; however, Deline teaches such a thickness (column 2 lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use such a thickness for the seal face part so that the cover was thin enough and flexible enough to enable a user to grip the opening tab using the film as well as enable to user to easily fold or peel back the material when opening the lid or when the lid is not in use.

Response to Arguments

12. The examiner acknowledges claims 1-18 are pending and claims 3-18 are withdrawn, as filed on August 5th, 2008.

13. The Examiner thanks the Applicant for resubmitting the required SB/08 form of the September 1, 2005 IDS. The required form was received on November 4th, 2008. The resubmission and corresponding receipt of original filing have overcome the objection to the IDS; therefore, the objection is withdrawn.

14. The drawings were received on August 5th, 2008. These drawings are acceptable. The objection to the drawings has been withdrawn.

15. Applicant's arguments, see amendment filed August 5th, 2008, with respect to the rejection of claims 1 under 35 U.S.C. §102(b) as being anticipated by Diaz and the rejection of claim 2 under 35 U.S.C. §103(a) as being obvious over Diaz in view of Deline (U.S. Patent No. 5,769,266) have been fully considered but are not persuasive.

The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior

Art Unit: 3781

art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

In response to Applicant's argument that Diaz includes additional structure not required by Applicant's invention, it must be noted that Diaz discloses the invention as claimed. The fact that it discloses additional structure not claimed, such as the structure of function relating to the snap fit between the lid and cover body and the additional step of application of heat or positioning an adhesive, does not make the claimed invention patentable over that of the reference since the claim in the instant application has the open ended term "comprising" which allows for more than that which is claimed to be included in the prior art.

The Examiner points out that the Applicant is arguing more than what is actually claimed. In response to Applicant's argument that Diaz does not include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., cap that engages the container itself to reseal, a cap that is self-sealing to the container) are not stated in the claims. It is the claims that define the claimed invention, and it is the claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ 2d 1064.

Regarding Applicant's contest of the gripping means, the Examiner emphasizes that the Applicant has only claimed "an entire top face of said container for canned drinks is covered in a water-tight manner by said seal face by attaching said outer-perimeter part below a seam part of said container for canned drinks" [emphasis

Art Unit: 3781

added]. Diaz only has to show the attachment being disposed below a seam part of said container to meet this claim, which is clearly shown by Diaz in Figures 1, 2, and 6. The Applicant has not set forth a specific engagement means as argued.

Regarding Applicant's contest of the outer -perimeter parts made as a film to expand and contract, the Examiner emphasizes that the Applicant has only claimed "an outer-perimeter part being an elastic material to expand and contract" [emphasis added]. Diaz discloses the body, which comprises the outer perimeter part is composed of a "thermoplastic material sufficiently pliable" (column 3 line 2). The word "pliable" dictates it has the ability to expand or contract. Thermoplastic is old and well known in the art as capable of expanding or contracting based on varying temperature. The requirement for a change in temperature is moot since the Applicant has not claimed that the product is restricted from varying conditions. Furthermore, the Applicant, in view of claim 2 and the specification, has defined that the outer-perimeter part is made of polystyrene or polypropylene and therefore this composition represents "an elastic material to expand and contract." Diaz discloses the material can be made of polystyrene (column 3 lines 52-53), and therefore satisfies the claim according to the Applicant's own definition and admission.

The remainder of the Applicant's arguments regarding the 35 U.S.C. §103(a) rejection of claim 2 are not persuasive for the reasons stated above. The Examiner contends that the rejection is proper and obvious.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NED A. WALKER whose telephone number is (571)270-3545. The examiner can normally be reached on Monday - Friday 7:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3781

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NW

/Anthony D Stashick/
Anthony D Stashick
Supervisory Patent Examiner, Art Unit 3781